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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,352	02/12/2004	Laurent Denoue	FX/A3020	5064
23910	7590	07/03/2007		
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER HUYNH, CONG LAC T	
			ART UNIT 2178	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/777,352

Applicant(s)

DENOUE ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. This action is responsive to communications: amendment filed 5/8/07 to the application filed on 2/12/04.
2. Claims 1-61 are pending in the case. Claims 1, 20, and 41 are independent claims.
3. The rejections of claims 1-61 under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of Barger on have been withdrawn in view of Applicant's arguments.

### *Claim Objections*

4. Claim 15 remains objected to because of the minor error: the word "and" in line 2 of the claim.

As mentioned in the previous office action, the "and" in line 2 is incorrect, not the "and" in line 3 as amended. There is nothing wrong in line 3.

It is suggested that the limitation in line 2 be changed as "the selecting, moving, modifying, or deleting step comprises:" so that there is an agreement between the subject "step" and verb "comprises."

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended independent claim 1 further recites:

- (c) selecting a first categorized annotation type where the first categorized annotation type is an anchor type
- (d) selecting a second categorized annotation type where the second categorized annotation type is selected from the group consisting of anchor type and comment type
- (e) selecting another categorized annotation type where the categorized annotation type is selected from the group consisting of anchor type, comment type and connector type
- (f) repeating step (e) and thereby generating ...

The added steps (c) to (f) are not disclosed in the specification of the application.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Independent claim 1 as amended recites repeating step (e), which is "selecting another categorized annotation type where the categorized annotation type is selected from the group consisting of anchor type, comment type and connector type", and thereby generating categorized annotations of the free from annotations based on anchor types, comment types and connector types where the anchor types, comment types and connector types are selected from a predetermined set of anchor types, comment types and connector types.

It is not clear why step (e) has to be repeated since if step (e) is repeated, the connector type has to be always selected twice whereas the other types are selected only once.

Dependent claims 2-19 are rejected for fully incorporating the deficiencies of their base claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. (US Pat App Pub No 2003/0070139, filed 9/16/02, priority 9/14/01).

Regarding independent claim 1, Marshall discloses:

- (a) reading and displaying a portion of a digital document on a screen based on one or more display properties of the screen (figures 3-4, [0037], [0038], [0028], [0082]: displaying a portion of a digital document can be carried out on a personal computer with normal size display or on a handheld device implies the document is read to be displayed based on one or more properties of the screen)
- (b) accepting one or more freeform annotations on the displayed portion of the digital document via one or more input devices (figures 2-4, [0035], [0056])
- (c) selecting a first categorized annotation type where the first categorized annotation type is an anchor type ([0037], figure 3, [0039]: the underline or text circle is the anchor type selected to apply on the document)
- (d) selecting a second categorized annotation type where the second categorized annotation type is a comment type ([0037], [0039]: the subsequent commentary on the page is the comment annotation type selected to apply on the document)
- (e) selecting another categorized annotation type where the categorized annotation type is selected from the group consisting of anchor type, comment type and connector type ([0037], [0039]: the arrows pointing out the circled adjacent text passage are the connector annotation type selected to apply on the document)
- generating categorized annotations of the free form annotations based on anchor types, comment types, and connector types ([0037], [0039], figure 3, [0042]: applying annotations of the free form annotations such as underlines, text circle,

commentary, and arrows on a document implies that these categorized annotations are generated)

- annotations applied on a document include underline, circling, commentary, arrows ([0037])
- (g) processing the one or more freeform annotations via a completely deterministic state machine ([0079])
- (h) indicating to the user the outcome of the processing of the one or more free-form annotations (figure 3, [0037])

Marshall does not disclose:

- repeating the step (e)
- where the anchor types, comment types and connector types are selected from a predetermined set of anchor types, comment types and connector types

However, it would have been obvious to an ordinary skill at the time of the invention was made to have modified Marshall to incorporate repeating step (e) during the process of applying an annotation on a document since it was well known to repeat a selection suitable to the need of a user. Further, it would have been obvious to an ordinary skill at the time of the invention was made to have modified Marshall to include a predetermined set of anchor types, comment types and connector types for selecting these annotation types since Marshall discloses all of the annotations belong to the types as in the claimed predetermined set. Having such predetermined set of these annotation types would make it easier for selecting annotations of various types to properly apply on a document.

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Regarding claim 2, which is dependent on claim 1, Marshall discloses that the method can be performed on one or more computing devices, wherein a computing device in the one or more computing devices can be one of: a PDA, a Tablet PC, a Pocket PC, a cell phone, an electronic message device, a Java-enabled device, a laptop or desktop PC, a workstation, and a mainframe computer ([0082]).

Regarding claim 3, which is dependent on claim 1, Marshall does not explicitly disclose that the method can be implemented in one or more of the following programming languages: C, C++, Visual Basic, Java and Java Applet.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Marshall to incorporate using one or more of programming languages C, C++, Visual Basic, Java and Java Applet to implement the method since these are well known programming languages to write a program.

Regarding claim 4, which is dependent on claim 1, Marshall discloses that the digital document can include at least one of: a text file, an image, a figure, a drawing, a graph, a picture, and a video clip ([0037]).

Regarding claim 5, which is dependent on claim 1, Marshall discloses wherein a display properties in the one or more display properties of the screen can be associated with one of: a text font, a font size, a text color, a display width, height, and resolution of the screen ([0041]: the font characteristics are ones of the display properties).



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Regarding claim 6, which is dependent on claim 1, Marshall discloses wherein a freeform annotation in the one or more freeform annotations can be one or more of strokes, gestures and handwritings of any shape ([0047], [0048]).

Regarding claim 7, which is dependent on claim 1, Marshall discloses wherein an input device in the one or more input devices can be one of a keyboard, a mouse, and a stylus ([0049], [0056]).

Regarding claim 8, which is dependent on claim 1, Marshall discloses storing the digital document in memory and/or in a persistent storage ([0057]).

Regarding claim 9, which is dependent on claim 1, Marshall discloses wherein the reading and displaying step comprises at least one of utilizing the control of the Microsoft Internet Explorer and accessing the Document Object Model to obtain the bounding box of the digital document ([0056]: the system for performing freeform annotations on documents using a connection over the Internet or intranet implies utilizing the control of a Internet browser such as Internet Explorer).

Regarding claim 10, which is dependent on claim 1, Marshall discloses reserving an area on the screen for the input of the one or more freeform annotations ([0040]).

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Regarding claim 11, which is dependent on claim 1, Marshall discloses managing one or more annotation marks on the displayed portion of the digital document by performing at least one of: creating, selecting, modifying, moving, deleting, rendering, and displaying an annotation mark of the one or more annotation marks on the screen based on the one or more display properties of the screen ([0047]: writing marks with pen strokes shows creating annotation marks with a pen).

Regarding claim 12, which is dependent on claim 11, Marshall discloses the annotation mark in the one or more annotation marks can be *one of*:

- an anchor capable of associating with a part of the portion of the digital document [0035]-[0036]: the circle, underline, and asterik, which are annotation marks, associated with a portion of a document to indicate that the importance of the portion, [0037]-[0038])
- a link capable of connecting at least two anchors
- a comment capable of associating with either an anchor or a connector

Regarding claim 13, which is dependent on claim 12, Marshall discloses that:

- the anchor can be one of: an underline, a highlight, a circled word, a circled area, a bracket, and a margin bar ([0036], [0038]-[0039])
- the link can be one of: an arrow, and a connector ([0037], [0040])

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Regarding claim 14, which is dependent on claim 1, Marshall does not explicitly disclose storing the one or more annotation marks in memory and/or in a persistent storage.

However, Marshall discloses detecting different types of annotation marks applied on a document ([0040]). This suggests that the annotation marks are stored in memory.

Regarding claim 15, which is dependent on claim 11, Marshall does not explicitly disclose that the selecting, moving, modifying, or deleting step comprises: tapping, holding, and lifting an input device in the one or more input devices on the annotation mark.

However, Marshall does disclose creating annotation mark with pen strokes ([0047]).

Therefore, it would have been obvious to an ordinary skill in the art at the time of the invention was made to modify Marshall to incorporate tapping, holding, and lifting an input device on the annotation mark since said tapping, holding, and lifting are “must do” actions when writing strokes on a document.

Regarding claim 16, which is dependent on claim 11, Marshall discloses that the rendering step comprises at least *one of*:

- retrieving a bounding box of the annotation mark ([0053])
- resizing and/or splitting the annotation mark
- repositioning the annotation mark on the portion of the digital document under display

Regarding claim 17, which is dependent on claim 12, Marshall discloses:

- reserving an area on the screen for the rendering of the comment ([0040]: writing marginalia implies that margin is reserved as an area to render a comment);  
and/or
- resizing and/or repositioning the comment based on one of the one or more display properties

Regarding claim 18, which is dependent on claim 12, Marshall discloses identifying the start of the comment by recognizing a freeform annotation in the one or more freeform annotations ([0040], [0042], wherein the freeform annotation is capable of starting on a blank area on the digital document under display ([0040]: the mark should be written on a blank area); and/or not intersecting with any word or image on the digital document.

Regarding claim 19, which is dependent on claim 12, Marshall discloses:

- identifying the finish of the comment by recognizing a freeform annotation in the one or more freeform annotations [0040], [0047] wherein the freeform annotation can be one of:
  - o a click on a predefined area on the screen, which can be a button
  - o a circular gesture around the comment ([0047], [0053]: clustering of marks with encompassing boxes shows a circular gesture around the comment)
  - o s strike-through gesture on the comment

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Claims 20-21, 23-34, 37-40 are the system of method claims 1-2, 4-13, 16-19, and are rejected under the same rationale.

Claims 22, 35-36 are the system of method claims 3, 14-15, and are rejected under the same rationale.

Claims 41-42, 44-47, 49-54, 56-61 are the system of method claims 1-2, 4-13, 16-19, and are rejected under the same rationale.

Claims 43, 48, and 55 are the system of method claims 3, 14-15, and are rejected under the same rationale.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection.

No response to arguments relating to Barger which is withdrawn from the rejection.

Regarding claim 10, Applicants argue that Marshall does not disclose "reserving an area on the screen for the input of the one or more freeform annotations" as cited in [0040].

Marshall discloses detecting the circle or the arrows in the text where the passages associated with more than one type of mark can be identified. This implies that there

are areas in the text for making circles or arrows. In other words, these areas are where to input freeform annotations of the text displayed on the screen.

Regarding claim 16, Applicants argue that Examiner does not specify where either Marshall or Bargerón teaches or suggest the limitation.

In response, it is noted that the claim recites that the rendering step comprises **at least one of**. Examiner only needs to show one of the “retrieving ..., resizing ..., and repositioning ...” which is the “retrieving a bounding box of the annotation mark” disclosed by Marshall at paragraph [0053] (see the claim rejection).

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Price et al. (US 6,766,494). Bargerón et al. (US 7,218,783).

Gupta et al. (US 6,917,965). Tao (US 2006/0048047).

Titemore et al. (US 2004/0243552).

Bargerón et al. (US 2006/0080598).

Zaher et al. (US 2005/0091027).

Spielberg et al. (US 2006/0143559).

Hollander et al. (US 2007/0118794).

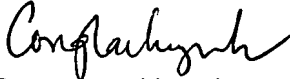
Bargerón et al., Reflowing Digital Ink Annotations, ACM 2003, pages 385-392.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Cong-Lac Huynh  
Primary Examiner  
Art Unit 2178  
6/20/07